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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,443	08/22/2003	Peter M. Allred	7678.792	9485

7590 11/01/2005

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EXAMINER

MANAHAN, TODD E

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

7/2/12

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/646,443		ALLRED ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Todd E. Manahan		3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/11/05</u>   | 6) <input type="checkbox"/> Other: ____.                                    |

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-51 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17, 24-30, 34, 36, 37, 39-41, 43, 49, 50 of copending Application No. 10/10/637,237 in view of Willison et al. (United States Patent Publication No. 2004/0005277). Willison et al. disclose it is known in the art to provide a treatment tray with a bleaching agent. It would have been obvious to one skilled in the art to provide the bleaching tray disclosed by Willison et al. with the desensitizing tray claimed in 10/637,237 in order to bleach the teeth and desensitize the teeth after treatment with the bleaching composition, as it is well known that the teeth become sensitive after bleaching treatment.

This is a provisional obviousness-type double patenting rejection.

Claims 1-51 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17, 41, 46-53 of copending Application No. 10/446,471 in view of Willison et al. (United States Patent

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Publication No. 2004/0005277). Willison et al. disclose it is known in the art to provide a treatment tray with a desensitizing agent. It would have been obvious to one skilled in the art to provide the desensitizing tray disclosed by Willison et al. with the bleaching tray claimed in 10/446,471 in order to desensitize the teeth after treatment with the bleaching composition, as it is well known that the teeth become sensitive after bleaching treatment.

This is a provisional obviousness-type double patenting rejection.

Claims 24-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 10/446,235 in view of Willison et al. (United States Patent Publication No. 2004/0005277). Willison et al. disclose it is known in the art to provide a treatment tray with a desensitizing agent. It would have been obvious to one skilled in the art to provide the desensitizing tray disclosed by Willison et al. with the bleaching tray claimed in 10/446,235 in order to desensitize the teeth after treatment with the bleaching composition, as it is well known that the teeth become sensitive after bleaching treatment.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willison et al. (United States Patent Publication No. 2004/0005277).

Willison et al. disclose a dental device comprising a treatment layer 190 in the shape of a dental tray comprising a front side wall, a rear side wall, and a trough between the front and rear sidewalls (see figures 1-5). The treatment layer comprises a treatment agent and a tooth adhesion agent that contributes to increased adhesiveness to the teeth when the treatment composition is moistened with saliva or water (see para. 0021). The treatment composition is a “substantially solid and coherent” composition in that it has physical characteristics such that it does not spill or squeeze out into the oral cavity when the device is placed on the teeth (see para. 0043). The treatment agent may be either a bleaching agent or a desensitizing agent. A moisture impervious barrier 170 is placed over the exposed surface of the bleaching composition. Willison et al. however does not disclose a kit comprising a bleaching tray and a desensitizing tray. It would have been obvious to one skilled in the art to provide a kit comprising a bleaching tray as disclosed by Willison et al. and a desensitizing tray also as disclosed by Willison et al. in order to desensitize the teeth after treatment with the bleaching composition, as it is well known that the teeth become sensitive after bleaching treatment or in order to treat normally sensitive teeth. Regarding claims 2-4, see para. 0121. Regarding claims 5-7, see para. 0114. Regarding claim 8, see para 0121. Regarding claim 9, see para 0108. Regarding claims 10-12, see para 109. Regarding claim 13, see para 0102. Regarding claims 14-16, see para. 0095. Regarding claims 17-18, see para. 0083. Regarding claims 19-21, see para. 0093. Regarding claim 23, see para. 0155. Regarding claim 26, see para 0055. Regarding claim 28, see para 0051.

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*Conclusion*

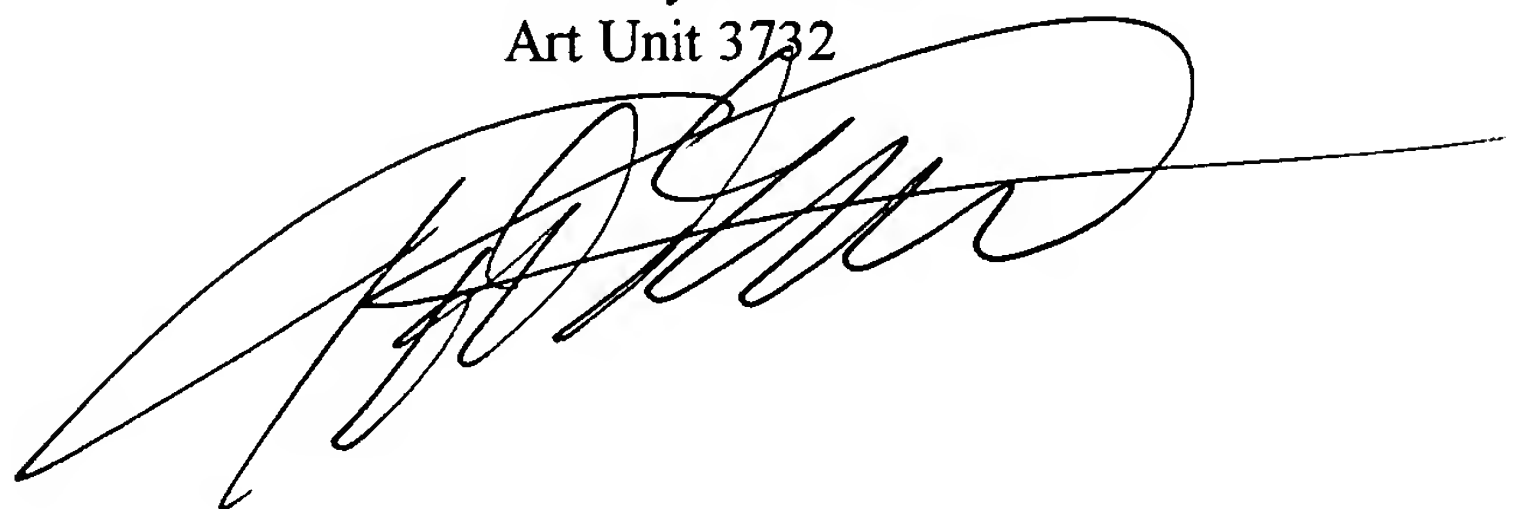
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 571 272-4713. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571 273-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan  
Primary Examiner  
Art Unit 3732

T.E. Manahan  
27 October 2005

A handwritten signature in black ink, appearing to read 'T.E. Manahan', is written over the printed name and title of the examiner.